REMARKS

Reconsideration of this application is requested. Claims 1-18 and 24-39 are in the case.

I. THE 35 U.S.C. § 112, SECOND PARAGRAPH, REJECTION

It is noted, with appreciation, that this rejection has been withdrawn.

II. THE 35 U.S.C. § 112, FIRST PARAGRAPH, REJECTION

It is noted, with appreciation, that this rejection has been withdrawn.

III. THE 35 U.S.C. § 112, SECOND PARAGRAPH, REJECTION

It is noted, with appreciation, that this rejection has been withdrawn.

IV. DOUBLE PATENTING

It is noted, with appreciation, that this rejection has been withdrawn.

V. THE OBVIOUSNESS REJECTION

Claims 1-15, 17, 18, 24, 25, 35-37 and 39 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent 4,959,373 to Lubisch et al. That rejection is respectfully traversed.

On page 3 of the Action dated May 20, 2003 (Paper No. 15), the Examiner has essentially required Applicants to disclaim all compounds wherein B-CR^5R^6-A forms a C_2-C_4 alkylene group. While Applicants do not wish to limit the claims to such an extent,

proviso (a) has been amended to specify that when R^7 is alkyl optionally substituted with a group selected from C_1-C_4 alkyl, halogen or C_1-C_4 alkoxy, then B-CR^5R^6-A does not represent a C_2-C_4 alkylene group. The reasoning for this proposed proviso language is as follows.

Lubisch does not disclose phenyl which can be substituted by anything at any position, but rather discloses optionally *PARA*-substituted phenyl where the optional substituent is chosen from C_1-C_4 alkyl, halogen or C_1-C_4 alkoxy (see page 1, lines 59-60 of Lubisch). Based on this disclosure, Applicants have disclaimed those compounds and wherein B-CR^5R^6-A forms a C_2-C_4 alkylene group.

In the Advisory Action dated March 15, 2004, the Examiner has asserted that the requested amendment raises the issue of new matter. This position is respectfully traversed.

It is believed that the Applicants are entitled to exclude subject matter of prior art pursuant to the decision of *In re Johnson*, 194 USPQ 187 (CCPA 1977). In that case, the court quoted from its decision in *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) as follows:

> "Inventions are constantly made which turn out not to be patentable, and Applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable."

The court went on to state:

> "It is for the inventor to decide what *bounds* of protection he will seek. *In re Saunders*, 58 CCPA 1316, 1327, 444 F.2d 599, 607, 170 USPQ 213, 220 (1971). To deny applicants the benefit of the grandparent application in this case would, as this court said in Saunders:
>
> > '... let form triumph over substance, substantially eliminating the right of an Applicant to retreat to an otherwise patentable species merely because

> he erroneously thought he was first with the genus when he filed.' " (Emphasis in the original).

In the *Johnson* case, the Appellants narrowed their claims to avoid them reading on a lost interference count (which was then prior art to them). The court noted that the Appellants were merely "excising the invention of another" to which they were not entitled, and were not "creating an 'artificial subgenus' or claiming 'new matter'."

In light of the decided case law, it is believed that the amendment presented in this case does not give rise to any issue of new matter. Entry and favorable consideration of the requested amendments are accordingly respectfully requested.

One of ordinary skill would not have been motivated to arrive at compounds falling within the scope of the presently claimed invention based on the Lubisch disclosure. Absent any such motivation, it is clear that a *prima facie* case of obviousness is not generated by Lubisch. Withdrawal of the outstanding obviousness rejection based on that reference is accordingly respectfully requested.

Allowance of the application is awaited.

Respectfully submitted,

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